

REMARKS

Claims 1-8 are pending in the present application. The May 28, 2003 Office Action objected to the drawings under 37 CFR 1.83(a) for failing to show every feature of the invention specified in the claims. Claims 1-7 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Additionally, claims 1-7 were rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 5,167,750 to Myers. Further, claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over Myers in view of United States Patent No. 5,147,469 to Hix. Applicants respectfully request reconsideration of the present claims in view of the following remarks after final as these remarks are believed to place the application in condition for allowance.

37 CFR 1.83(a) Objection

The drawings are objected to under 37 CFR 1.83(a) for failing to show every feature of the invention specified in the claims.

In relation to the objection under 37 CFR 1.83(a), the Examiner states that the alternate embodiments argued by the Applicants' Amendment of April 29, 2003, with regard to claim 1, must be shown, or the features must be canceled from the claim(s). As for the Examiner's argument that the alternate embodiments of the claims must be shown in the drawings, Applicants respectfully assert that "[i]t is black letter law that a specification (or drawing) need not describe every possible embodiment covered by the claim to satisfy the written description requirement." *Mahurkar v. Arrow Int'l, Inc.*, 160 F. Supp. 2d 927, 939 (N.D. Ill. 2001); *See American Photocopy Equip. Comp. v. Rovico, Inc.*, 257 F. Supp. 192, 196 (N.D. Ill. 1966) (rejecting the argument that claims broader than the drawings cause invalidity and holding that an inventor is not required to submit innumerable drawings of every conceivable device because the requirement that the best mode be described does not mean that all modes or all possible embodiments of the invention be described). In *Mahurkar*, the court held that the word "cone" in the claim

language was not limited to the right circular cone illustrated in the figures and could encompass off-center cones because the drawings did not have to include every possible embodiment covered by the claim.

Similarly, claim 1 of the present application was intended to cover many embodiments such as a first embodiment wherein the drive mechanism and the driven biasing member may be linked to the same platen, as shown in the drawings, and in alternatives such as where the drive mechanism and the driven biasing member may be linked to different platens. Furthermore, claim 1 was intended to cover a first embodiment wherein the drive mechanism and the driven biasing member may be linked to only one of the platens, as shown in the drawings, or in the alternative, the drive mechanism and the driven biasing member may be attached to both of the platens. Based on the established precedent, the drawings of the present application are not required to illustrate every possible embodiment encompassed by the language of claims. Therefore, Applicants assert that the drawings do not have to be supplemented to show the alternate embodiments of claim 1.

With regard to the Examiner's alternative argument that the features of the alternate embodiments not covered by the drawings must be canceled from the claims, the Applicants respectfully assert that "the mere fact that the patent drawings depict a particular embodiment of the patent does not operate to limit the claims to that specific configuration." *Prima Tek II, L.L.C. v. Polypap, S.A.R.L.*, 318 F.3d 1143, 1148-49 (Fed. Cir. 2003). Thus, the Applicants assert that the features of the alternate embodiments do not have to be canceled from the claim language.

§112 Rejections

Claims 1-7 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

In relation to the rejection under §112, the Examiner states that claim 1 is indefinite because it is unclear if the drive mechanism and the driven biasing member are both linked to the same or different platens and because claim 1 recites that the drive mechanism and the driven biasing member are linked to at least one platen, but the

drawings only show these components linked to one platen. As discussed above, the drawings need not show every possible embodiment covered by the claims. Furthermore, the specification expressly provides support for alternative embodiments such as at page 9. The fact that a claim has breadth and covers multiple embodiments does not make the claim indefinite. MPEP §2173.04.

§103 Rejections

Additionally, the Examiner has rejected claims 1-7 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,167,750 to Myers. The Examiner further asserts that it would have been obvious at the time of the invention to one of ordinary skill in the art to reverse the biasing member such that the second platen is biased toward the first platen since mere reversal of the essential working parts of a device allegedly involves only routine skill in the art. Further, claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Myers in view of U.S. Patent No. 5,147,469 to Hix. Applicants traverse the rejections to claims 1-8.

§103 Rejection Over Myers

Claim 1 recites that a platen press device comprises a driven biasing member that increases an impression force between the first and second platens. The impression force increased by the driven biasing member forces the first and second platens together.

The Examiner notes that Myers does not disclose the driven biasing member increasing an impression force between the first and second platens. The Examiner relies on what is allegedly “common knowledge” in the art to reverse the biasing member such that the second platen is biased toward the first platen to cure the deficiency of Myers. As explained in the MPEP §2144.03(B), general conclusions concerning what is “basic knowledge” to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record supporting such conclusions will not support an obviousness rejection. *See In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). If an examiner is going to take official notice of a fact, the examiner must provide “specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.” MPEP §2144.03(B); *See In re Soli*, 317 F.2d

941, 946 (CCPA 1963). However, in the present case, the Examiner provides no evidence, scientific reasoning, or reference to support the allegation that reversing the biasing member so that the second platen is biased towards the first platen is "common knowledge" to one skilled in the art. Applicants request that the Examiner provide such a reference illustrating the use of a biasing member in the direction necessary to increase an impression force if the rejection is to be sustained.

Moreover, even if such evidence or reference was provided, Applicants assert that Myers teaches away from reversing the biasing member such that the platens are biased towards one another instead of away from one another. Accordingly, there is no motivation to combine Myers with a reference that teaches reversing the biasing member such that the platens are biased towards one another to increase an impression force between the platens since the biasing force of the springs disclosed by Myers is used to "counterbalance some of the weight of the upper platen to relieve fatigue of the operator and to insure that the upper platen is held in its open position" (see column 3, lines 15-19). To suggest that it would have been obvious to reverse the biasing members disclosed by Myers so that the upper platen was biased toward the lower platen is to defeat the main purpose of the biasing members as taught by Myers, since such a combination would make it even more difficult for the operator to separate the platens and for the upper platen to remain in its open position. Any §103 rejection based on Myers is impermissible. For at least these reasons, the rejection of claims 1-8 based on Myers should be withdrawn.

§103 Rejection Over Myers In View of Hix

Claim 8 stands rejected as being obvious over Myers in view of Hix. As discussed above, Myers fails to teach increasing the impression force between the platens and instead teaches away by providing springs positioned to urge the platens apart. Accordingly, there is no motivation to combine Myers with any reference, including Hix, to reject the claims of the present application because the springs taught by Myers are used to separate the platens instead of increase the impression force between the platens. Moreover, Hix also fails to teach a biasing member that increases the impression force between the platens. Instead, Hix teaches a hydraulic cylinder that operates to urge

clockwise rotation of a toggle box (Figs. 2-3) which acts to separate the upper platen from the lower platen rather than to increase the impression force between them. Accordingly, claim 8 is allowable over Myers in view of Hix. Furthermore, for at least the reasons stated above, claims 1-8 are allowable over Myers. Since claim 8 depends from claim 1 and recites additional features, Applicants respectfully submit that claim 8 is also allowable over Myers in view of Hix for at least these additional reasons.


CONCLUSION

For at least these reasons, Applicants assert that the pending claims 1-8 are in condition for allowance, and respectfully request that the Examiner pass this application with claims 1-8 to allowance. Should the Examiner have any questions, please contact Applicants' undersigned attorney at 404.954.5040.

Respectfully submitted,

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